

### REMARKS

The above-referenced application was filed with claims 1-30. In a first office action the Examiner cited the publication of this very same application against itself. In response, the applicants therefore pointed this error out to the Examiner and he withdrew the rejection. However, rather than allowing the claims, he then rejected the pending claims based on two newly cited references. By way of this amendment, claims 1 and 20 are amended and claim 21 is cancelled. Accordingly, claims 1-20 and 22-30 remain pending and at issue.

First with respect to claims 1-4 and 20-21, the Examiner has rejected such subject matter as anticipated by McFarland, U.S. Patent No. 5,048,689. The Examiner states that "McFarland discloses a disposable cutting board" when in fact it is a paperboard corner post used in cardboard boxes and the like to reinforce the corners of shipping boxes. Applicant has read McFarland from cover to cover and finds no reference whatsoever to cutting boards, much less disposable cutting boards. Accordingly, McFarland fails to disclose each and every element of the pending claims and therefore the anticipation rejection must fail.<sup>1</sup>

Notwithstanding this omission in the McFarland reference, applicants have further amended claim 1 to read the cutting board element from the preamble of the claim into the body of the claim and thus give life and meaning to the cutting board limitation. More specifically, the claim has now been amended to specify that the cutting board is movable between a planar cutting configuration to a curved, serving configuration by folding the cutting board about the afore-defined scoreline. Support for such a limitation is found in the specification at page 8, paragraph 27. McFarland even more clearly fails to disclose such elements and thus the anticipation rejection must fail.

With respect to claims 5-19 and 27-30, the Examiner has rejected such subject matter as obvious over McFarland in view of Wantanabe, U.S. Patent No. 5,562,872. Wantanabe at least discloses a cutting board, but is entirely directed to the material from which the board is manufactured, namely antibacterial material, such as synthetic rubber and hard chloroethene. However, regardless of the material from which the Wantanabe board is made, it clearly does not include any score lines or means of folding whatsoever. Accordingly, these rejections must fail as well.

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<sup>1</sup> Anticipation under 35 USC §102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Rockwell International Corp. v. United States* 47 USPQ2nd 1027 (Fed. Cir. 1998).

With respect to claims 18, 19, and 27-30 the Examiner fails to provide any specific reasoning for the rejection. They are largely grouped within the overall rejection based on McFarland and Wantanabe, but rather than addressing the specific limitation of those claims as he did with claims 7-9, 11, 14, 15, 25, 26, and 29, he is silent. However, applicants wish to point out the patentability of such subject matter and deserve at least an examination thereof. More specifically, claims 18 and 19 are directed to a method of using a disposable cutting board including the steps of placing a cutter board formed from a plurality of corrugations atop the work surface, cutting matter atop the board, folding the cutting board along scorelines to form a trough, and dispensing the matter from the board by tilting the trough. McFarland, as it does not even disclose a cutting board, clearly fails to disclose such a method. Wantanabe, while disclosing a cutting board, disclosing nothing as to the method of using such a board nor does it disclose any structure which would enable such folding and dispensing action. Accordingly, as one requirement of any *prima facie* case of obviousness is the disclosure of each and every element of a pending claim, such an obviousness rejection must fail as well.<sup>2</sup>

Finally, with respect to claims 27-30, such claims specify the structure and method of using a cutting board having first and second layers wherein the first layer allows for knife penetration without dulling the knife, and the second layer requires greater force to penetrate than the first layer. Again, as McFarland fails to disclose any form of cutting board what so ever, it clearly can not disclose such a structure or method. Moreover, as each of the layers of McFarland is manufactured from the same material, even if it were to be used as a cutting board, these limitations of claims 27-30 would not be met. With respect to Wantanabe, again as it discloses only a specific material such as synthetic rubber or chloroethene for forming a cutting board, it clearly does not disclose multiple layers, much less one wherein the multiple layers include a first layer for knife penetration and a second layer requiring greater force than the first layer. In light of this, these obviousness rejections must fail as well.

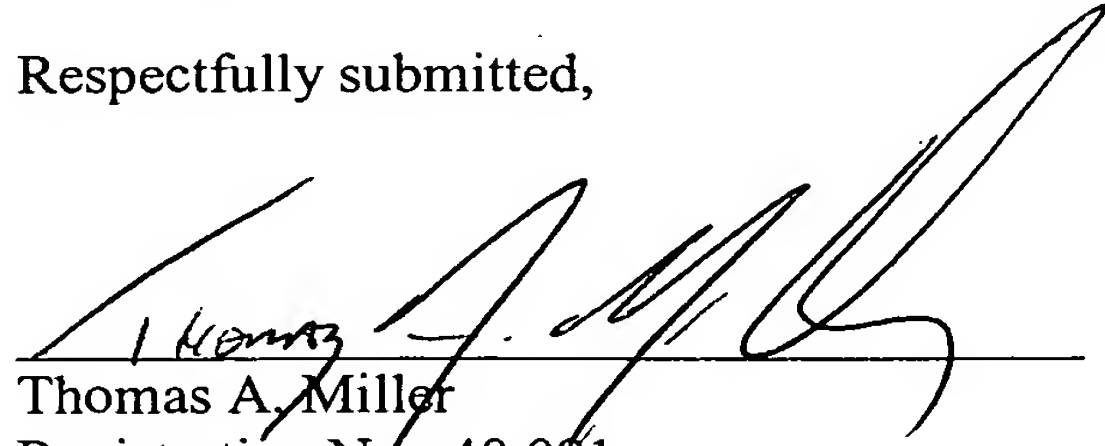
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<sup>2</sup> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP §2143

In light of all the foregoing, the applicants respectfully submit that claims 1-20 and 22-29 are in condition for allowance and respectfully solicit same. Should the Examiner have any questions, he is invited to telephone the undersigned.

Respectfully submitted,

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